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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,872	01/03/2005	Hans Rudolf Czemy	CZERNY-1 PCT	9324
25889	7590	01/16/2007	EXAMINER	
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			JUSKA, CHERYL ANN	
			ART UNIT	PAPER NUMBER
			1771	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/16/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/519,872	CZERNY, HANS RUDOLF
	<b>Examiner</b>	<b>Art Unit</b>
	Cheryl Juska	1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4 is/are rejected.
- 7) Claim(s) 5-18 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 December 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 5-18 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 5-18 have not been further treated on the merits.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Said claims are indefinite for claiming the invention in terms of physical properties rather than the chemical or structural features that produce said properties. *Ex parte Slob*, 157 USPQ 172, states, “Claims merely setting forth physical characteristics desired in an article, and not setting forth specific composition which would meet such characteristics, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in the future and which would impart said desired characteristics.” Also, “it is necessary that the product be described with sufficient particularity that it can be identified so that one can determine what will and will not infringe.”

*Benger Labs, Ltd v. R.K. Laros Co.*, 135 USPQ 11, *In re Bridgeford* 149 USPQ 55, *Locklin et al.*

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v. *Switzer Bros., Inc.*, 131 USPQ 294. Furthermore, “Reciting the physical and chemical characteristics of the claimed product will not suffice where it is not certain that a sufficient number of characteristics have been recited that the claim reads only on the particular compound which applicant has invented.” *Ex parte Siddiqui*, 156 USPQ 426, *Ex parte Davission et al.*, 133 USPQ 400, *Ex parte Fox*, 128 USPQ 157. Claims 1-4 are rejected for claiming the hot melt adhesives in terms of melt flow rate and melting points rather than by chemical composition.

***Claim Rejections - 35 USC § 102/103***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. 103(a) as being unpatentable over US 5,540,968 issued to Higgins.

Higgins discloses a carpet comprising a tufted primary backing, a precoat adhesive, a backcoat adhesive and a secondary backing, wherein both the precoat and backcoat adhesives may be hot melt adhesives applied in sequential steps (abstract, col. 4, lines 19-24 and 42-44, and Figure 3A).

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Although Higgins fails to explicitly teach the presently claimed limitations to melt flow rates and melting points, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e., hot melt precoat and hot melt backcoat adhesives) and in the similar production steps (i.e., application of said adhesives sequentially) used to produce the carpet. The burden is upon applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 495. In the alternative, the claimed melt flow rates and melting points would obviously have been provided by the process disclosed by Higgins. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. Therefore, claim 1 is rejected as being anticipated by or obvious over the cited Higgins reference.

***Claim Rejections - 35 USC § 103***

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Higgins patent.

While the reference fails to teach the mass per unit area of the hot melt adhesives, claim 2 is rejected as being obvious over the cited Higgins reference. Specifically, it would have been obvious to one skilled in the art to employ a mass per unit area in the amounts recited by applicant, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Therefore, claim 2 is rejected as being obvious over the prior art.

***Allowable Subject Matter***

9. Claims 3 and 4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim 3 limits at least one of the hot melt adhesives (5,6) to comprising mineral microbodies and/or hollow mineral microbodies (7), while claim 4 limits said microbodies to hot melt adhesive (6). It is known in the carpet art to include said microbodies or microspheres as filler in secondary cushion layers. See US 5,656,109 issued to Schilling et al., col. 5, lines 35-52 and 6,838,147 issued to Burns, Jr. et al., abstract. Additionally, it is known to include microspheres in adhesive backcoats for carpets, wherein said backcoat comprises latex rather than hot melt adhesive. See US 3,819,463 issued to Ervin et al., abstract and col. 1, lines 39-60, GB 1 404 849 assigned to Dow Chemical, abstract, and JP 91-057762 B assigned to Asahi Chemical, abstract. Furthermore, hot melt adhesives containing microspheres are known. See US 4,906,497 issued to Hellmann et al., col. 5, line 67-col. 14 and JP 09-208913 A assigned to Sekisui Chemical, abstract. While Hellmann does employ said hot melt adhesive in carpet applications, said application is drawn to carpet installation adhesives and not precoat and backcoat adhesives. US 2005/0038160 issued to Hall et al. discloses ethylene copolymer adhesives comprising hollow fillers (e.g., microspheres) suitable for use in automotive carpets (abstract, section [0058], and section [0119]). However, said Hall reference is not available as prior art due to an effective filing date of August 15, 2003, while the present application has an effective filing date of June 18, 2003. Since there is no teaching or fair suggestion to one of ordinary skill in the art to incorporate mineral microbodies and/or hollow mineral microbodies

into a hot melt adhesive precoat and/or hot melt adhesive backcoat in a carpet construction, claims 3 and 4 contain allowable subject matter.

***Conclusion***

10. The art made of record and not relied upon is considered pertinent to applicant's disclosure.
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CHERYL A. JUSKA  
PRIMARY EXAMINER